

REMARKS/ARGUMENTS

The rejections presented in the Office action dated March 26, 2004 have been considered. Claims 1-24 and 26-47 remain pending in the application, while Claim 25 has been canceled. Reconsideration of the pending claims and allowance of the application in view of the present amendment and response is respectfully requested.

Claims 1, 3-4, 7, 14, 24-25, 28-29, and 45-46 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,615,038 to Moles et al. (hereinafter Moles).

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicants respectfully submit that Moles does not teach every element of Claim 1 and therefore fails to anticipate Claim 1.

Applicants' Claim 1 teaches a method of initiating provisioning procedures for terminals operating in a mobile communications network which at least: automatically detects an unprovisioned terminal in the mobile communications network; and provides a notification to a provisioning server to initiate the provisioning procedures for the unprovisioned terminal in response to the automatic detection of the unprovisioned terminal. Thus, in order for the Moles' disclosure to anticipate Applicants' Claim 1, Moles must teach a provisioning procedure which is automatically triggered after a determination has been made that an unprovisioned terminal exists within the network. Further, Moles must also teach that the provisioning procedure has been initiated because an unprovisioned terminal has been detected.

In contrast, however, Moles appears to teach that provisioning of mobile terminals is either triggered spontaneously, or in response to a mobile station upgrade request message.

(Column 8, lines 48-51). In the case of spontaneously triggered provisioning, Moles seems to teach the use of timer 315 in conjunction with scheduling data stored in update schedule file 313 to perform periodic or scheduled mobile station updates. (Column 7, lines 35-47; Column 7, lines 48-59; and Column 8, lines 14-25). It appears, therefore, that configuration updates taught by Moles are not triggered by detection of an unprovisioned mobile terminal, but rather that configuration update software is gathered periodically. Configuration updates may then occur in response to a manual configuration update request sent by the mobile station itself, or periodically as defined by timer 315, update schedule file 313, and associated scheduling data.

Alternately, the Office Action suggests that Moles identifies a mobile station as being unprovisioned and then performs a provisioning procedure on the mobile station. (Column 6, lines 27-32). This procedure is discussed in more detail in Column 7, lines 24-28 and lines 60-66, and Column 8, lines 1-13, however, which defines a procedure that is in contrast to Applicants' claimed invention. In particular, Moles first teaches that software configuration files are to be requested and subsequently stored within mobile station parameter files 320-350 (see column 7, lines 24-28, and step 425 of FIG. 4) thus beginning the provisioning procedure. Second, mobile station update controller 305 locates one or more mobile stations having a specific manufacturer's identification number or range of hardware revision numbers. (Column 7, lines 60-66, and Column 8, lines 1-4). Moles, however, must first request the mobile station's configuration by transmitting a mobile station configuration request message to the mobile station. (Column 8, lines 32-35). Third, if mobile station update controller 305 determines that a manufacturer's identification code of a mobile station matches the manufacturing code associated with the previously stored software configuration files, then a software update to that mobile station is commenced. (Column 8, lines 8-15, and step 430 of FIG. 4). It can be seen, therefore, that the provisioning process of Moles is initiated before any mobile stations needing provisioning have been located, since software configuration files are gathered before any mobile stations requiring provisioning have been identified. Further, the provisioning procedure taught by Moles is not initiated in response to detecting an unprovisioned mobile station, but is rather initiated periodically according to a predetermined update schedule.

Thus, while Moles first locates mobile station software configuration files that may be available from respective mobile station manufacturers, the Applicants' claimed invention instead automatically detects mobile stations that are in need of provisioning. Further, while Moles attempts to match any mobile stations to previously received software configuration files, the Applicants' claimed invention instead issues a notification to a provisioning server to provision the automatically detected unprovisioned mobile terminal. Thus, Applicants respectfully submit that Moles' disclosure fails to anticipate Applicants' Claim 1, therefore, Applicants' Claim 1 is in condition for allowance.

Claim 46 sets forth substantially equivalent features as discussed above in relation to Claim 1. Therefore, Applicants respectfully submit that Claim 46 also patentably distinguishes over Moles for at least the same reasons given above in relation to Claim 1 and is, therefore, in condition for allowance.

With respect to Applicants' Claim 28, a provisioning system is set forth to automatically provision terminals in a mobile communications network. A detection module, e.g., 112, is coupled to the mobile communications network to monitor for at least a subscriber identifier and an equipment identifier transmitted from an unprovisioned terminal. Further, a provisioning trigger module, e.g., 114, is coupled to the detection module to generate a provisioning notification based on the subscriber and equipment identifiers indicating that the unprovisioned terminal has been introduced on the mobile communications network. Still further, a provisioning server, e.g., 116, is coupled to receive the provisioning notification and to instigate provisioning procedures with the unprovisioned terminal in response to the provisioning notification. It is respectfully submitted, however, that the Office Action fails to establish that each of these elements is taught by Moles and, therefore, fails to show how Moles' disclosure anticipates Applicants' Claim 28.

In particular, the Office Action suggests equating: Applicants' detection module with Moles' MS update controller 305; Applicants' provisioning trigger module with Moles' mobile station configuration database 310; and Applicants' provisioning server with Moles' configuration server 160. In so doing, however, the Office Action necessarily creates a third element, configuration server 160, from a combination of the first two elements, MS

update controller 305 and mobile station configuration database 310. Such a characterization is an impossibility as illustrated in FIG. 3 of Moles, since element 160 fully encompasses elements 305 and 310, along with timer 315. Either elements 305 and 310 combine to create single element 160, or they stand alone, but they cannot do both simultaneously as is suggested by the Office Action.

In addition, while the Office Action inherently suggests that Moles' MS update controller 305 teaches the monitoring of both a subscriber identifier and an equipment identifier, as one of the functions performed by Applicants' detection module, e.g., 112, is to monitor both a subscriber identifier and an equipment identifier, no such teaching is to be found in the Moles specification. Rather, Moles only discloses storage of data associated with the mobile station including manufacturing identification code, hardware revision number, software revision number. (Column 6, lines 66-67, and Column 7, lines 1-2). Thus, since the subscriber identification is not stored by Moles, it follows that the subscriber identification cannot be monitored by Moles either. Applicants submit, therefore, that Claim 28 patentably distinguishes over Moles and is in condition for allowance.

Dependent Claims 3-4, 7, 14, 24-25, 29, and 45 which are dependent from independent Claims 1 and 28, respectively, are also rejected under 35 U.S.C. §102(e) as being unpatentable over Moles.

Applicants' submit that the rejection of Claim 25 is moot in view of the cancellation of Claim 25. Further, while Applicants do not acquiesce with the particular rejections to the other dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent Claims 1 and 28. These dependent claims include all of the limitations of the base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 3-4, 7, 14, 24, 29, and 45 are also in condition for allowance.

Claims 2, 8-13, 15-17, 19-22, 26-27, and 47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moles in view of U.S. Patent No. 5,809,413 to Meche et al. (hereinafter Meche).

To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. (M.P.E.P. §2142). Applicants submit that at least criteria 3) has not been met by the Office Action as discussed in more detail below, and thus fails to establish a *prima facie* case of obviousness.

In particular, Claim 47 sets forth at least a provisioning system for automatically provisioning terminals in a mobile communications network. The mobile communications network comprises a means for monitoring for a subscriber identifier identifying a particular subscriber and an equipment identifier identifying an unprovisioned terminal, a means for automatically detecting the unprovisioned terminal in the mobile communications network, which includes a means for determining that the subscriber and equipment identifiers do not collectively correspond to known subscriber and equipment affiliations, and a means for providing a notification to a provisioning server to initiate a provisioning procedure for the unprovisioned terminal in response to the automatic detection of the unprovisioned terminal.

As discussed above in relation to Claim 28, however, Moles fails to teach the storage of a subscriber identifier that identifies a particular subscriber and consequently must also fail to teach a means for monitoring the subscriber identifier. In addition, as discussed above in relation to Claim 1, Moles' provisioning process is initiated before any mobile stations needing provisioning have been located, since software configuration files are gathered before any unprovisioned mobile stations have been identified. This aspect of Moles is in contrast to Applicants' Claim 47 because Applicants' provisioning server initiates a provisioning procedure after the automatic detection of the unprovisioned terminal has occurred. In addition, the provisioning procedure of Applicants' Claim 47 is initiated because an unprovisioned terminal is detected in the network, rather than because software configuration update files are available, as taught by Moles.

The Office Action correctly posits on page 5 that Moles fails to teach or suggest automatically detecting an unprovisioned terminal by determining that the subscriber and equipment identifiers do not collectively correspond to known subscriber and equipment affiliations. The Office Action, therefore, suggests a combination of Moles and Meche to remedy the deficiencies of Moles.

Applicants respectfully submit, however, that Moles is additionally deficient in that Moles' provisioning procedure is not triggered by a detection of an unprovisioned mobile terminal, which is in contrast to Applicants' claimed invention. Rather, the provisioning procedure of Moles begins by first downloading any software configuration updates that may be available for any number of mobile stations. After downloading such software configuration updates, Moles determines which mobile stations may benefit from the software configuration updates by transmitting mobile station configuration request messages to the mobile stations and then commencing a procedure to download the software configuration files to the applicable mobile stations.

Meche, however, fails to remedy these deficiencies. Rather, Meche is directed to the deactivation of a mobile terminal through a comparison of the mobile terminal's IMEI with a stolen list, in contrast to a comparison of an equipment identifier with a subscriber identifier as set forth in Applicants' claimed invention. (See abstract of Meche). Thus, while the combination of Moles with Meche fails to teach or suggest a provisioning procedure that is triggered by a detection of an unprovisioned mobile terminal as discussed above in relation to Claim 1, the Office Action additionally mischaracterizes Meche as performing a comparison of an equipment identifier with a subscriber identifier. Thus, Applicants respectfully submit that the combination of Moles and Meche fails to teach or suggest all of the limitations of Applicants' Claims 1 or 47. As such, Meche taken alone, or in combination with Moles, fails to establish a *prima facie* case of obviousness. Applicants submit, therefore, that Claim 47 is in condition for allowance.

Dependent Claims 2, 8-13, 15-17, 19-22, 26-27, which are dependent from independent Claim 1, are also rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Moles and Meche. While Applicants do not acquiesce with any particular rejections to these dependent claims, it is believed that these rejections are now

moot in view of the remarks made in connection with independent Claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." M.P.E.P. §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2, 8-13, 15-17, 19-22, 26-27 are also allowable over the combination of Moles and Meche.

Applicants further assert that: recognizing that the affiliated identifier pair does not match any of the stored identifier pairs; continuously monitoring the identifier pairs; and the use of WAP and SyncML-based protocols during automatic provisioning procedures taken in response to a detection of an unprovisioned terminal, do not constitute facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. The references relied on in the Office Action do not disclose these purportedly well known facts, and the Applicants contend that reasonable doubt exists regarding the circumstances justifying the Office Action's exercise of official notice. The Applicants therefore respectfully request that any subsequent Office Action provide evidence that demonstrates the appropriateness of the officially noticed facts pursuant to MPEP § 2144.03. Applicants reserve the opportunity to respond to any subsequent official action concerning any such judicially noticed facts.

Furthermore, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Taking official notice of the above-discussed "facts" disregards the requirement of analyzing Applicants' claimed subject matter "as a whole." Applicants respectfully reiterate the legal tenet that facts so noticed should not comprise the principle evidence upon which a rejection is based. MPEP § 2144.03.

Claims 5, 30-34, and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moles in view of U.S. Patent No. 5,404,355 to Raith. Claims 6, 38-41, and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moles in view of U.S. Patent No. 6,636,502 to Lager et al. (hereinafter Lager). Claim 14 stands rejected

under 35 U.S.C. §103(a) as being unpatentable over Moles in view of U.S. Patent No. 6,282,421 to Chatterjee et al. (hereinafter Chatterjee). Claims 18 and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moles in view of Meche, and in further view of U.S. Patent No. 6,519,468 to Donovan et al. (hereinafter Donovan). Claim 23 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Moles in view of Meche, and in further view of U.S. Patent No. 5,819,177 to Vucetic et al. (hereinafter Vucetic). Claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Moles in view of Raith, and in further view of Vucetic. Claim 42 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Moles in view of Lager, and in further view of Donovan.

While the Office Action correctly identifies in paragraphs 7-13 other elements and attributes of Applicants' present invention that are not taught or suggested by Moles, and while the Office Action suggests combining Moles with Raith, Lager, Chatterjee, Donovan, and Vucetic, as necessary to remedy those missing elements and attributes, the Office Action nevertheless has failed to remedy Moles' deficiencies with respect to Applicants' independent claims.

In particular, as discussed above in relation to independent Claims 1, 28, 46, and 47, Moles first locates mobile station software configuration files that may be available from respective mobile station manufacturers, thus commencing the provisioning process before detecting the presence of unprovisioned mobile stations. The Applicants' claimed invention, on the other hand, automatically detects unprovisioned mobile terminals. Further, Moles attempts to match any mobile stations to previously received software configuration files, but must first query each mobile station through a mobile station configuration message. The Applicants' claimed invention, on the other hand, issues a notification to a provisioning server to provision the automatically detected unprovisioned mobile terminal with the necessary configuration data in response to detecting the presence of the unprovisioned mobile terminal.

Thus, Applicants respectfully submit that Moles taken alone, or in combination with one or all of Raith, Lager, Chatterjee, Donovan, or Vucetic also fails to establish a *prima facie* case of obviousness, since any combination with Moles is also necessarily deficient as

discussed above. Therefore, Claims 5-6, 14, 18, 23, and 30-43 are in condition for allowance.

If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him at 651-686-6633 (x110) to discuss any issues related to this case.

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Respectfully submitted,

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